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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

ATTORNEY DOCKET NO.: AUS000060US1

In re Application of:

RABINDRANATH DUTTA

Serial No.: **09/535,559**

Filed: **March 27, 2000**

For: **THIRD PARTY CONTRACT
DEPOSITORY FOR E-COMMERCE
TRANSACTIONS**

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Examiner: **RUDY, ANDREW J.**

Art Unit: **3627**

Confirmation No. **3609**

APPEAL BRIEF UNDER 37 C.F.R. 41.37

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Sir:

This Brief is submitted in support of the Appeal of the Examiner's final rejection of Claims 5, 7, 11-14 and 19-20 in the above-identified application. A Notice of Appeal was filed in this case and received in the Patent Office on January 18, 2008. Please apply the previously paid fee for filing of the previous Appeal Brief, to cover the fees for filing the present Appeal Brief. A one month extension of time is required and is hereby requested. Please charge the fee of \$120.00 for the one month extension of time to **DILLON & YUDELL LLP's Deposit Account No. 50-3083**. Please charge any additional required fees to **IBM's Deposit Account No. 09-0447**.

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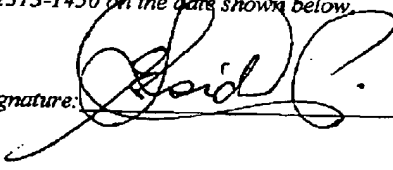
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REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 010712, frame 0812.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 5, 7, 11-14 and 19-20 stand rejected by the Examiner as noted in the Office Action dated October 18, 2007. The rejection of Claims 5, 7, 11-14 and 19-20 is appealed.

STATUS OF AMENDMENTS

Appellants' Appeal Brief, filed on September 10, 2006, resulted in reopening prosecution as noted in the Office Action dated October 18, 2007. No amendment was made subsequent to the Office Action from which this appeal is taken.

SUMMARY OF THE CLAIMED SUBJECT MATTER

As recited by Appellants' example Claim 5, Appellants' invention provides an electronic database used as a depository 207 for electronic documents 209 generated during E-commerce transactions (FIG. 3 and 4). The electronic database comprises: means for automatically receiving an electronic document (209) dynamically generated from information provided during an E-commerce transaction (FIG. 4; page 13) that has completed at an E-commerce server 205 (see FIG. 4, 411, which server is independent of the electronic database (207) (see FIG. 5B; page 14, first paragraph), whereby the electronic document 209 stored at the electronic database cannot be modified by either party to the E-commerce transaction (see top of page 12 – first full paragraph); means for generating a document identifier (ID) (see 209) for the received E-commerce generated electronic document 209, wherein the document ID is generated at the database (505) (see page 14, second paragraph); means for storing the E-commerce generated

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electronic document 209 with the document ID (*id.*; also *see* bottom of page 12); and means for transmitting the document ID (209) to each party to the E-commerce transaction that produced the electronic document (FIG. 5B).

Example Claim 11 provides a depository 207 for ensuring authenticity of electronic documents generated during E-commerce transactions. The depository comprises: means for enabling automatic receipt of an electronic document that is dynamically generated in response to a completion of an E-commerce transaction in which information utilized to generate the electronic document is provided, wherein the E-commerce transaction is completed at a server 205 that is independent of the depository 207; means for generating a document identifier (ID) to identify the E-commerce generated electronic document 209 being stored at the depository 207, wherein the document ID is generated at the depository 207 and is separate from a transaction ID assigned to the E-commerce transaction; and means for storing the E-commerce generated electronic document 209 in the depository 207 along with the document ID that is utilized to reference and retrieve the electronic document 209 from the depository 207.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. The Examiner's rejection of Claims 5, 7, 11-14 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over *Ginter* (U.S. Patent No. 7,143,290) (hereinafter *Ginter*) is to be reviewed on Appeal.

ARGUMENT

- A. The rejection of Claims 5, 7, 11-14 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over *Ginter* is not well founded and should be reversed.

A. 1 General requirements for a claim rejection under 35 U.S.C. § 103

According to 35 U.S.C. §103(a):

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

In order to make the obviousness determination, the U.S. Supreme Court held in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) (hereinafter *John Deere*) that three factors must be considered:

- (1) the scope and content of the pertinent prior art;
- (2) differences between the pertinent prior art and the invention at issue; and
- (3) the ordinary level of skill in the pertinent art.

In *KSR Intern. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007), the U.S. Supreme Court clarified that a non-obviousness determination must include an inquiry as to "whether the improvement is more than the predictable use of prior art elements according to their established functions."

A.2 *Ginter* does suggest to one of skilled in the art the subject matter of Appellants' Example Claim 5.

Appellants' example Claim 5 recites the following features, among others, which are not taught nor suggested by *Ginter*:

- (1) means for automatically receiving an electronic document dynamically generated from information provided during an E-commerce transaction that has completed at an E-commerce server, which server is independent of the electronic database, whereby said electronic document stored at said electronic database cannot be modified by either party to the E-commerce transaction; and
- (2) means for generating a document identifier (ID) for said received E-commerce generated electronic document, wherein said document ID is generated at said database;

Examiner correctly states that *Gitner* discloses an automatically generated E-commerce transaction. However, Examiner then incorrectly states that *Gitner* teaches, within the figure illustrations, a laundry list of components that includes a server (4150) "that provides for no modifications to the document." The server 4150 is presented within Figure 96, described at col. 20, lines 30-48. Nowhere within that description is there any teaching or suggestion of the server being one that does not allow the electronic document to be modified by either party to an E-commerce transaction. Examiner fails to appreciate that generation of an E-commerce transaction is not synonymous with or suggestive of Appellants' claimed features recited above

(i.e., features related to dynamic generation of an E-commerce document that cannot be modified).

Examiner makes a general assertion by pointing to the figures generally and to the referenced elements as teaching the above recited features of Appellants' claimed invention. Having noted that *Gitner* does not "explicitly teach (sic) the document dynamically generated" Examiner points to *Gitner's* mention of a dynamic interface (PPE 650). Examiner then takes "Official Notice" that "dynamically generated documents have been common knowledge in the database transaction art." Examiner provides no basis for this unsupported assertion, and Examiner fails to connect the database transaction art to an E-commerce transaction, which is the focus of Appellants' claimed invention. *Gitner* does not provide any support for that assertion. Thus, Appellants respectfully traverse Examiner's attempt to reject Appellants' claimed invention on the basis of an unsupported assertion, and Appellants request that Examiner provide a reference to support that assertion.

Further, Examiner opines that "motivation" for generating a document dynamically "would have been to obtain a more secure document." There is no rational basis for this conclusion, as nothing within the "dynamic production" of a document by itself makes the document secure. Absent the specific teachings of Appellants' claimed invention, which specifically includes the dynamic production at a server that is a write once, read many storage device (as also claimed), no security or added security is obtained for the document based on a dynamic production/generation of the document. Examiner's attempt to find motivation from within *Gitner* to teach these features of Appellants' invention fails the base premise required to reach the conclusion provided by Examiner.

Examiner also fails to point to specific teachings within *Gitner* being relied upon to support the rejection of Appellants' dependent claims. For example, none of the figures or references therein (by themselves or in combination) teach or suggest the functional features provided by the elements of Claim 7 ("means for preventing modifications to said E-commerce generated electronic document after said document has been stored") or Claim 14 ("when said depository also stores other documents that are not generated by the E-commerce transactions,

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means for flagging each E-commerce generated electronic document stored within said electronic depository to allow only a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction, wherein write access is permitted for said other documents that are not flagged").

For the above reasons, the rejections of the above example Claim 5, as well as of all other pending claims within Appellants' invention, are not well founded and should be reversed.

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CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections and the claim language which renders the invention patentable over the primary reference and the various combinations of references. Appellants, therefore, respectfully request that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,



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APPENDIX

1-4. (canceled)

5. An electronic database used as a depository for electronic documents generated during E-commerce transactions, comprising:

means for automatically receiving an electronic document dynamically generated from information provided during an E-commerce transaction that has completed at an E-commerce server, which server is independent of the electronic database, whereby said electronic document stored at said electronic database cannot be modified by either party to the E-commerce transaction;

means for generating a document identifier (ID) for said received E-commerce generated electronic document, wherein said document ID is generated at said database;

means for storing said E-commerce generated electronic document with said document ID; and

means for transmitting said document ID to each party to said E-commerce transaction that produced said electronic document.

6. (canceled)

7. The electronic database of Claim 5, wherein said means for storing further comprises:

means for allowing a later read access to said E-commerce generated electronic document by a party to said E-commerce transaction; and

means for preventing modifications to said E-commerce generated electronic document after said document has been stored.

8-10. (canceled)

11. A depository for ensuring authenticity of electronic documents generated during E-commerce transactions, said depository comprising:

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means for enabling automatic receipt of an electronic document that is dynamically generated in response to a completion of an E-commerce transaction in which information utilized to generate said electronic document is provided, wherein said E-commerce transaction is completed at a server that is independent of said depository;

means for generating a document identifier (ID) to identify said E-commerce generated electronic document being stored at the depository, wherein said document ID is generated at said depository and is separate from a transaction ID assigned to the E-commerce transaction; and

means for storing said E-commerce generated electronic document in said depository along with said document ID that is utilized to reference and retrieve said electronic document from said depository.

12. The depository of Claim 11, wherein said storing means includes:

means for limiting a write access of said electronic document to a first access; and

means for restricting subsequent access to said electronic document to read-only access, such that no changes may be made to said electronic document once it has been stored.

13. The depository of Claim 11, further including:

means for controlling a read and write access to said electronic depository, wherein said electronic document is stored in a write-once, read-many format;

means for providing said document ID to each party of the E-commerce transaction; and

means for later retrieving said electronic document for read access by a party to said E-commerce transaction utilizing said document ID.

14. The depository of Claim 13 wherein said controlling means further includes:

means for enabling a non-modification function for said electronic document, wherein a control code of said electronic depository is activated to prevent later modification to said electronic document; and

when said depository also stores other documents that are not generated by the E-commerce transactions, means for flagging each E-commerce generated electronic document stored within said electronic depository to allow only a later read access to said E-commerce

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generated electronic document by a party to said E-commerce transaction, wherein write access is permitted for said other documents that are not flagged.

15-18. (canceled)

19. The electronic database of Claim 5, further comprising:

means for connecting said electronic database to a separate, independent server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said electronic database via said connecting means.

20. The depository of Claim 11, further comprising:

means for connecting said depository to a separate, independent server at which said E-commerce transactions are conducted; and

means for enabling communication between said server and said depository via said connecting means.

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EVIDENCE APPENDIX

Other than the Office Action(s) and reply(ies) already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Appellants, Appellants' legal representative, or assignee.

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